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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,496	04/25/2001	Mark Ashby	032005-092	9267

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EXAMINER
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CHOI, STEPHEN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/843,496	<b>Applicant(s)</b> ASHBY ET AL.	
	<b>Examiner</b> Stephen Choi	<b>Art Unit</b> 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11, 12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In view of applicant's remarks filed on 24 March 2005 stating that the claims are directed to a subcombination of a cutting device, it is now unclear whether the claims should be construed as a subcombination of a cutting device or a combination of a cutting device and a medical device system in view of *In re Larsen* (see MPEP § 2173.02 [R-1]). The following rejections under 35 USC 102(b) set forth below are based on the claims directed to the subcombination of the cutting device and the rejections under 35 USC 103(a) are based on the claims directed to the combination of the cutting device and the medical device system.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-12, and 17 are rejected under 35 U.S.C. 102(b) as anticipated by Jones (US 2,847,759) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jones in view of Krol (US 4,573,576).

Jones discloses all the recited elements of the invention including a base (24) having an opening with cutting edges (26), a flap (22) having a shape corresponding to the opening and cutting edges corresponding to the cutting edges of the opening. Regarding claim 12, a guide edge (27 of Jones). It is noted that Jones satisfies all the claimed structural limitations and is capable of being mounted on a card that supports a medical device system.

Or, in the alternative, if the claims are directed to the combination of the cutting device and the medical device system on the card,

Jones discloses the invention substantially as claimed except for the base mounted on a card that supports a medical device system. Krol teaches mounting a medical kit on a card to provide easy access to the tools within the kit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the device of Jones on the card as taught by Krol in order to provide easy access to the tools within the kit. Moreover, one having ordinary skill in the art would have been motivated to mount the cutting device on the card in order to provide a ready to use cutting device on the card supporting the medical device system. It has been

held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

***Response to Arguments***

6. Applicant's arguments with respect to claims 11-12 and 17 have been considered but they are not persuasive.

In view of applicant's arguments, which appear to be based on the combination of the cutting device and the medical device system contrary to application's statement mentioned above on paragraph 2, the following remarks are made.

Applicants contend that one having ordinary skill in the art would not have been motivated to mount the cutting device of Jones on a card since the use of the cutter will be difficult. In addition, applicants request to provide a reference to support the examiner's statement regarding the common knowledge or well-known in the art statement of the previous office action.

The claim merely calls for a base of a cutting device being mounted on a card. Whether the cutting device of Jones can be used easily while being mounted on the card or not is not at issue. The issue at hand is whether it would have been obvious to one skill in the art to mount the cutting device of Jones on a card with other devices to form a kit. Krol teaches forming a kit containing various medical devices mounted on a card so as to provide easy access to the devices within the kit. Furthermore, it is well known in the medical art to include a cutting device as part of a medical kit (e.g., references to Alpern et al., Deac et al., or Prouse). Thus, it is the examiner's position that one skill in the art would have been motivated to provide a cutting device of Jones

as part of a kit on a card as taught by Krol to arrive at the claimed invention. In addition, Krol teaches putting at least two devices together to form a kit on a card (forming into one piece article).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deac et al. and Perouse.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC  
25 May 2005



**STEPHEN CHOI**  
**PRIMARY EXAMINER**